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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/901,692 07/28/97 KAMAKURA

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EXAMINER

STAAS & HALSEY  
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SUITE 500  
WASHINGTON DC 20001

KAZIMI, H

ART UNIT

PAPER NUMBER

2765

*15*

DATE MAILED:

05/10/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/901,692</b>	Applicant(s) <b>Kawasaki-Shi et al.</b>
	Examiner <b>Hani Kazimi</b>	Group Art Unit <b>2765</b>

Responsive to communication(s) filed on Mar 10, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1, 3-12, and 14 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1, 3-12, and 14 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

1. This action is responsive to the communication filed on March 10, 2000.

### *Status of Claims*

2. Of the original Claims 1-10, claims 1, and 2 have been amended by Applicants' amendment filed on March 25, 1999. The same amendment has added claims 11-14. In the amendment filed on March 10, 2000, claims 2, and 13 have been canceled, and claims 1, 11, 12, and 14 have been amended. Therefore, claims 1, 3-12, and 14 are under prosecution in this application.

### *Summary of this Office Action*

3. Applicants' arguments filed on March 10, 2000 have been fully considered, and discussed in the next section below or within the following rejection under 35 U.S.C. § 103 are not deemed to be persuasive, and Applicants' request for allowance is respectfully denied.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the

manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

6. Claims 1, and 11, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama US Patent No. 5,913,202 in view of Wyman "a model for improving consumer acceptance of telemarketing", hereinafter Wyman.

Motoyama reference is described with reference to providing financial services to consumers. Applicant's invention is claimed with reference to providing goods to consumers. However, through out the specification of Applicant's present invention, Applicant discloses that the system is providing goods or services to the consumers (e.g. pages 1, and 8). Even though, Motoyama's system is specific to providing financial services, and Applicant's invention is providing goods or services but claims only the use of goods, it is clear that both systems are in the same environment. Therefore, the pending claims are rejected based on the interpretation that Applicant's goods are the same as Motoyama's services, since Applicant's disclosure refers to using the system for providing goods or services to the consumers.

Claims 1, and 11, 12, and 14, Motoyama teaches a marketing system and method for processing market information of consumers and dealers via an electronic network (abstract, and figure 1), comprising:

personal information registering means for registering personal information of a consumer (column 3, line 61 through column 4, line 33, and column 6, lines 16-28);

market information registering means for registering market information about services which the consumer desires to purchase (column 4, lines 23-58; and column 6, lines 6-28);

posting means for extracting and posting the market information registered in said market information registering means according to genres (column 3, line 61 through column 4, line 53); and

personal information acquiring means for acquiring personal information of the consumer necessary for a dealer to access the consumer from said personal information registering means when the market information posted at said posting means is purchased (column 4, lines 3-53, column 6, lines 6-34, and column 7 thru column 8, line 10).

Motoyama fails to teach the prior approval demand determining means for determining, based on the personal information registered in said personal information registration means, whether prior approval by the consumer is required before the dealer accesses the consumer, and access confirming means for seeking approval for access by the dealer from the consumer who registered the purchased market information, when prior approval is required.

Wyman teaches the steps of determining, based on the personal information registered in

Art Unit:2765

said personal information registration means, whether prior approval by the consumer is required before the dealer accesses the consumer, and seeking approval for access by the dealer from the consumer who registered the purchased market information, when prior approval is required (page 1).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Motoyama to include steps of determining, based on the personal information registered in said personal information registration means, whether prior approval by the consumer is required before the dealer accesses the consumer, and seeking approval for access by the dealer from the consumer who registered the purchased market information, when prior approval is required because, it benefits both the dealers and the consumers by better understanding the consumer's needs and better targeting of promotional programs, and it provides a secure system by preventing any consumer's confidential information from being exposed to other dealers.

Claim 3, both Motoyama and Wyman fail to teach that the access confirming means cancels the purchase of the market information by the dealer when the consumer does not approve the dealer's access.

Official notice is taken that canceling a purchase or an order based on denying access is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's

Art Unit:2765

invention was made to modify the teachings of Motoyama to include the step of canceling the purchase of the market information by the dealer when the consumer does not approve the dealer's access because, it greatly improves the efficiency of the system.

Claims 4, and 5, Motoyama teaches the personal information registered in said personal information registering means includes a type of access to the consumer (column 6, lines 6-34); and

the type of access includes at least one of indirect or direct electronic mail, indirect or direct facsimile transmission, indirect or direct mail of material, telephone call, and visit (column 6, lines 6-34).

Claim 6, Motoyama teaches the personal information registered in said personal information registering means includes pre-categorized information and format-free information (figure 3, and column 6, lines 6-34)

Claim 7, Motoyama teaches the accounting means for charging the dealer when the dealer has purchased the market information posted at said posting means (column 6, lines 6-34).

Claim 8, both Motoyama and Wyman fail to teach the step of performing at regular intervals of time a process of inquiring of the consumer whether the consumer desires the market

Art Unit:2765

information to be continuously posted at said posting means.

Official notice is taken that performing at regular time intervals an inquiry as to whether continuously post information is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to implement the system of Motoyama to include the step of performing at regular intervals of time a process of inquiring of the consumer whether the consumer desires the market information to be continuously posted at said posting means because, it provides convenience to the consumer by keeping him/her updated of the posted information, it greatly improves the efficiency of the system, and provides both the consumers and the dealers with a system that is user friendly.

Claims 9, and 10, both Motoyama and Wyman fail to explicitly teach the point providing means for giving the consumer a bonus point when the consumer has registered the personal information or market information; and

the point providing means gives the consumer an extra point if the consumer purchases goods from the dealer who has purchased the market information.

Official notice is taken that bonus points and incentives for registering personal information and purchasing goods and services is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to implement the system of Motoyama to include the point providing means

Art Unit:2765

for giving the consumer a bonus point when the consumer has registered the personal information or market information and when the consumer purchases goods from the dealer because, it provides the consumer the opportunity to save money on their purchases, and provides the dealers the chance to increase their sales.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 3-12, and 14 have been considered but are moot in view of the new ground(s) of rejection. The response to Applicant's arguments with respect to the claims are mentioned above in the 35 U.S.C. § 103 rejection of this office action.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Walker et al. US Patent 5,884,270 Mar. 16, 1999, a system for facilitating employment searches by establishing communication channels between the employer and the candidates, while maintaining their anonymity.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

Art Unit:2765

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hani.Kazimi

May 5, 2000



TOD R. SWANSON  
SUPERVISORY PATENT EXAMINER  
GROUP 2700